



*IFW*

PTO/SB/21 (02-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	<b>10/648,451</b>
Filing Date	<b>08/26/2003</b>
First Named Inventor	<b>Johannes Aebi</b>
Art Unit	<b>1614</b>
Examiner Name	<b>D.M. Seaman</b>
Attorney Docket Number	<b>20806 US1</b>

Total Number of Pages in This Submission

**3**

### ENCLOSURES (Check all that apply)

- |  |   |  |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form                                | <input type="checkbox"/> Drawing(s)                                       | <input type="checkbox"/> After Allowance communication to Group                            |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Licensing-related Papers                         | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences        |
| <input checked="" type="checkbox"/> Amendment/Reply                          | <input type="checkbox"/> Petition   | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final   | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information   |
| <input type="checkbox"/> Affidavits/declaration(s)                           | <input type="checkbox"/> Power of Attorney, Revocation                    | <input type="checkbox"/> Status Letter   |
| <input type="checkbox"/> Extension of Time Request                           | <input type="checkbox"/> Change of Correspondence Address                 | <input type="checkbox"/> Other Enclosure(s) (please Identify below):                       |
| <input type="checkbox"/> Express Abandonment Request                         | <input type="checkbox"/> Terminal Disclaimer                              |  |
| <input type="checkbox"/> Information Disclosure Statement                    | <input type="checkbox"/> Request for Refund                               |  |
| <input type="checkbox"/> Certified Copy of Priority Document(s)              | <input type="checkbox"/> CD, Number of CD(s) _____                        |  |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application    | Remarks   |  |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |   |  |

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	<b>John P. Parise</b>
Signature	
Date	<b>05/17/2005</b>

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	<b>John P. Parise</b>		
Signature		Date	<b>05/17/2005</b>

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Inventor(s): Aebi et al.

Group: 1614

Serial No. 10/648,451, filed August 26, 2003

Examiner: D. M. Seaman

For: DIHYDROINDOLE AND TETRAHYCROQUINOLINE DERIVATIVES

**COMMUNICATION IN RESPONSE TO OFFICE ACTION**

Nutley, New Jersey 07110  
May 17, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Communication is filed in response to the Office Action mailed May 10, 2005.  
A response to this Office Action is due June 10, 2005.

In the Office Action restriction was required under 35 U.S.C. § 121. Specifically, there are allegedly two independent and distinct groups of inventions. Group I includes claims 1-27 and 29-30, in whole, and claim 28, in part, wherein  $m=2$ . Group II includes claim 28, in part, wherein  $m=1$ .

In response to this restriction requirement, applicants elect, with traverse, to prosecute at this time the invention of Group I. Applicants traverse this restriction for

Serial No. 10/648,451  
Filed: August 26, 2003

the reasons set forth in the response to restriction in the parent application, now U.S. Patent No. 6,706,751. Upon notice of allowable subject matter in claim 28, applicants would amend claim 28 to recite  $m=2$ , and would consider filing a further divisional patent application.

If a telephone conference would be of assistance in furthering prosecution, applicants request that the undersigned attorney be contacted at the number below.

No fee is required in connection with the filing of this Communication. If any fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



Attorney for Applicant(s)  
John R. Parise  
(Reg. No. 34,403)  
340 Kingsland Street  
Nutley, NJ 07110  
Telephone (973) 235-6326  
Telefax: (973) 235-2363

156437